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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,481	07/29/2003	Gerard M. Cuomo	2946	7459
7590	03/25/2004		EXAMINER	
Beck & Tysver, P.L.L.C. Suite 100 2900 Thomas Avenue S. Minneapolis, MN 55416			KING, ANITA M	
			ART UNIT	PAPER NUMBER
			3632	

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/629,481	CUOMO, GERARD M.
	Examiner	Art Unit
	Anita M. King	3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 29 July 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-3 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-3 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 29 July 2003 is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

This is the first office action for application number 10/629,481, Surgical Microscope Apparatus, filed on July 29, 2003.

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "26" has been used to designate both an adjustable clamp and a dental chair. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: "3," in Fig. 4. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the

Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informality: reference character "5" is used to represent two different elements in the specification, a pin on page 4, line 10 and for an aperture on page 4, line 13.

Appropriate correction is required.

Claim Objections

Claim 1 is objected to because of the following informality: there is an inconsistency between the language in the preamble and certain portions in the body of the claim, thereby making the scope of the claim unclear; the preamble indicates a subcombination; the applicant is required to clarify what the claims are intended to be drawn to, i.e., either the surgical microscope system alone or the combination of the surgical microscope system and the dental chair. In formulating a rejection on the merits, the examiner is considering that the claims are drawn to the subcombination and the claims will be rejected accordingly. If applicant indicates by amendment that the combination claim is the intention, the language in the preamble should be made consistent with the language in the body of the claims. If the intent is to claim the subcombination, then the body of the claims must be amended to remove positive recitation of the combination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 has ambiguous claim terminology where it is unclear whether latter recitations of originally cited terminology are intended to refer to the originally cited terms. It is unclear if "a dental chair," bridging lines 4 and 5 of the claim is intended to refer to the original recitation of the term "a dental chair," bridging lines 1 and 2 of the claim. Applicant is suggested to change the later recitation to either --the dental chair-- or --said dental chair--.

Claim 2 recites the limitation "said vertical support" bridging lines 2 and 3 and line 4 and "said microscope support" in line 3. There is insufficient antecedent basis for these limitations in the claim. The original recitations are cited as "a substantially vertical microscope support arm," in line 4 and "a horizontally movable microscope positioning arm" in line 6 of the claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,571,038 to Jako. Jako discloses a surgical microscope system for operating a surgical microscope over a dental chair of the type having a hinge for rotating the patient position near the patient's hips, comprising: a substantially vertical microscope support arm (see Fig. 1) adapted for fitment on a dental chair adapted for vertical motion in concert with chair vertical motion (Col. 3, line 16ff); a horizontally movable microscope positioning arm (14) having a plurality of hinged links, connected to the vertical support arm; and a microscope coupler (12) for connecting the microscope to the positioning arm; whereby the microscope system is supported for vertical motion and location the support arm; and whereby motion of a portion of the chair is used to focus the microscope.

Jako inherently discloses a method of using a surgical microscope with a chair having a movable chair bottom and having a rotatable chair back comprising the steps of: mounting a microscope on a substantially vertical pole connected to a dental chair bottom; moving the chair bottom to position the microscope at a location comfortable for the microscope user; and rotating the seat back about a pivot point bringing the subject into approximate focus of the microscope.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jako in view of U.S. Patent 4,548,373 to Komura. Jako discloses the claimed invention except for the limitation of a terminal link. Komura teaches that it is known in an arm linkage system to have a supporting device comprising a horizontally movable microscope positioning arm (2 and 3) having a plurality of hinged links, connected to a vertical support arm (10), and including a terminal link (30) with a repositionable axis of rotation orthogonal to the vertical support arm proximate the microscope, whereby the microscope support arm may be inclined at an angle with respect to the vertical support arm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the positioning arm in Jako to have included the terminal link as taught by Komura for the purpose of increasing the degree of adjustability to the positioning arm.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 2,967,458 to Stone, Jr.

U.S. Patent 3,186,300 to Littmann

U.S. Patent 3,776,614 to Kloots et al.

U.S. Patent 3,809,454 to Brambring

U.S. Patent 4,695,024 to Haven

U.S. Patent 4,856,741 to Schaefer

U.S. Patent 5,480,212 to Marconet

U.S. Patent 5,609,316 to Tigliev

Stone, Jr. discloses an instrument for use by a surgeon in viewing the field of operation under magnification. Littmann discloses a double-stereo microscope and illuminator for surgical operations. Kloots et al. disclose a long-viewing-distance microscope system. Brambring discloses a microsurgical-operating unit having a mobile chair for a surgeon and a positioning arm for a microscope. Haven discloses an adjustable arm for controlling horizontal and vertical positioning of an object mounted at one end of the arm. Schaefer discloses an adjustable patient support table having an adjustable arm. Marconet discloses a medical instrument positioner including a lever arm pivotally secured at a first end to a stationary base, which is a base of a patient support, such as an examine chair and including a pole extending upwardly therefrom for supporting an adjustable arm for supporting a microscope. Tigliev discloses a suspension system for a surgical microscope.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita M. King whose telephone number is (703) 308-2162. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie A. Braun can be reached on (703) 308-2156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anita M. King
Primary Examiner
Art Unit 3632

March 20, 2004